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QUELER, ADAM M

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Ex parte WILLIAM J. BAER, JAMES A. BARKER,
EDWARD HANAPOLE, ROBERT C. HARTMAN, JR.,
ENGENE JOHNSON, JR., I-MING KAO, JANET L. MURRAY,
JERRY D. ROBERTSON III, and RICHARD W. WALKUS

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Appeal 2011-009257
Application 09/489,143[1]
Technology Center 2100

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Before THU A. DANG, CAROLYN D. THOMAS, and
JAMES R. HUGHES, *Administrative Patent Judges.*

THOMAS, *Administrative Patent Judge.*

DECISION ON APPEAL

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[1] The real parties in interest are International Business Machines
Corporation, Pearson Education, Inc., and Richard W. Walkus.

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1-24, which are all the claims remaining in the application. Claims 25-27 are cancelled. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

The present invention relates generally to "creating compilations of content from hierarchical content stored in a data repository." *See* Spec., 2: 7-8.

Claim 1 is illustrative:

1.   A computer-implemented method for determining the cost of and producing a user-defined content object comprising:

defining said content object in accordance with user selection and arrangement of a plurality of content entities for said content object, wherein the content object is a digital object within the computer in the form of one of a book, a collection of images, an album, a video and a multimedia object, and the content entities each include content comprising digital data, are stored within a data repository as a plurality of individually accessible file objects, and are selectively associated with an actual content count representing the quantity of content within that content entity; and

generating a price for the user to produce the user-defined content object, wherein said price is one of an actual price and an estimated price selected based on a parameter setting and said price generation includes:

generating an estimated content count for the selected content entities that represents an estimated quantity of content within the content object, wherein the digital data within the selected content entities are utilized to determine the estimated content count representing the estimated quantity of content within the content

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object, and generating from the estimated content count the estimated price to serve as the price for the user to produce the user-defined content object with the selected content entities in response to said parameter setting indicating the estimated price, wherein the estimated price is determined based on a price per unit of content, and wherein the unit of content represents a predetermined quantity of content and the estimated content count indicates an estimated quantity of said units of content for the selected content entities; and

generating the actual price to serve as the price for the user to produce the user-defined content object from the actual content counts of the selected content entities in response to said parameter setting indicating the actual price.

Appellants appeal the following rejections:

1. Claims 1, 2, 7-10, 15-18, 23, and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Norris (US 6,147,768, Nov. 14, 2000) and Ogawa (US 6,072,479, June 6, 2000); and

2. Claims 3-6, 11-14, and 19-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Norris, Ogawa, and Dedrick (US 5,768,521, June 16, 1998).

ANALYSIS

Our representative claim, claim 1, recites, *inter alia*, "*wherein the estimated price is determined based on a price per unit of content, and wherein the unit of content represents a predetermined quantity of content*" (emphasis added). Independent claims 9 and 17 recite commensurate limitations. Thus, the scope of each of the independent claims includes generating an estimate price from a predetermined quantity of content.

Issue: Did the Examiner err in finding that the combined teachings of Norris and Ogawa, particularly Ogawa, teaches and/or suggests that "the estimated price is determined based on a price per unit of content," as claimed?

The Examiner found that "Ogawa specifically teaches wherein the estimate price for generating the multimedia application was directly related to the size of the collection of calculated surrogate media objects." (Ans. 14) (citation omitted).

Appellants contend that "the Ogawa patent determines the cost based on development time (or man hours) and the price per hour, whereas the independent claims recite the estimated cost to be based on the price for a unit of content and the estimated quantity of those units within the content object." (App. Br. 19.) We agree with Appellants.

Here, the Examiner has indicated that Norris does not teach the argued limitation (Ans. 5-6) and has instead directed our attention in part to a calculation module in Ogawa which uses "the development time as the base to calculate the development cost" (Ans. 14 citing Ogawa, col. 13, ll. 48-50). While we agree with the Examiner that Ogawa does indeed calculates the size of actual media data and adds up the media data sizes to estimate a total size (Abstract, *see also* col. 3, ll. 35-37), the Examiner has not shown where Ogawa teaches and/or suggests determining an *estimated price* based on this estimated total size, as required by the claims.

Instead, Ogawa discloses that "the calculation module adds up actual media creation costs for calculation of an estimate of the cost of each media type" (Abstract, *see also* col. 3, ll. 41-47). Ogawa further discloses "the

development time as the base to calculate the development cost" (col. 13, ll. 48-50). In other words, Ogawa either uses "actual media creation costs" or "development time" in determining the cost of the media. However, the Examiner has failed to demonstrate that Ogawa determines an *estimate price* based on the quantity/size of content, as required by the claims.

Simply asserting that "the concept of relating an amount of information/product to be purchased to its cost is well known in the commerce" (Ans. 14) is unsupported speculation by the Examiner, which does not amount to a finding supportive of the Examiner's obviousness conclusion, given the above explicit teachings in Ogawa regarding determining estimated cost based on "actual cost" and "development time."

Based upon our review of the record, we find the weight of the evidence supports the Appellants' positions as articulated in the Briefs. Since we agree with at least one of the arguments advanced by Appellants, we need not reach the merits of Appellants' other arguments. It follows that Appellants have shown that the Examiner erred in finding that the combined teachings, particularly Ogawa, renders independent claims 1, 9, and 17 unpatentable. Dependent claims 2-8, 10-16, and 18-24 are reversed for similar reasons.

DECISION

We reverse the Examiner's § 103 rejections of claims 1-24.

REVERSED

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